

REMARKS

Favorable reconsideration and allowance of the present application in view of the foregoing amendments and following remarks are respectfully requested.

Currently, claims 1-19 and 41-58 remain pending in the present application, including independent claims 1, 14 and 47. In general, the claims are directed to an elastic film that contains a thermoplastic polyurethane elastomer and a filler. The film has been stretched in an amount sufficient to form micropores adjacent to the filler particles. For instance, the film layer may have a WTVR of at least $1000 \text{ g/m}^2 - 24$ hours.

As now amended, claims 1 and 14 now require the microporous film layer or the elastomer layer to "consist essentially of" a thermoplastic polyurethane elastomer. Support for this amendment can be found throughout the specification including reference to the examples.

As stated in Section 2111.03 of the Manual of Patent Examining Procedure, the phrase "consisting essentially of" is typically used and defined in the context of compositions and limits the scope of a claim to the specified materials or steps and those that do not materially affect the basic and novel characteristics of the claimed invention. Thus, when used in claims 1 and 14, the phrase "consisting essentially of" does not exclude the inclusion of additives, such as stabilizers, in the film layer and other materials that would not materially affect the basic and novel characteristics of the elastic film defined in those claims.

The Examiner's attention is also directed to new claim 47. In claim 47, the film is defined as having an original length, a stretched length, and a final unbiased length.

The stretched length is defined as being from about 4 times to about 7 times the original length of the film while the final unbiased length is from about 2 times to about 5 times the original length. As stated on page 18 of the present specification, the present inventor discovered that by stretching the film and then partially relaxing the film, the elastic properties of the film can be improved while still remaining breathable. In the examples, various films were partially relaxed after being stretched. It is believed that through this process, films are formed having unique and desirable characteristics.

In the Office Action, claims 1 and 14 were rejected under 35 U.S.C. § 102 in view of U.S. Patent No. 5,445,862 to Kaneko. Kaneko is directed to a porous film that contains three necessary components. The first component is an ethylene-alpha-olefin copolymer present in the film in an amount from 65% to 90% by weight. The second component is a thermoplastic elastomer present in an amount from 10% to 35% by weight. Finally, the film further contains an inorganic filler.

As opposed to claims 1 and 14 as now amended, however, Kaneko fails to disclose or suggest a film layer or an elastomer layer that consists essentially of a thermoplastic polyurethane elastomer. Instead, Kaneko teaches that the primary component of the film disclosed therein is an ethylene-alpha-olefin copolymer. Thus, it is believed that claims 1 and 14 patentably define over Kaneko.

Further, with respect to independent claim 47, Applicant submits that Kaneko also fails to disclose or suggest a film having an original length, a stretched length, and an unbiased final length such that the stretched length is about 4 times to about 7 times the original length and the final unbiased length is from about 2 times to about 5 times the original length. Instead, Kaneko merely states that the stretch ratio of the film

disclosed therein is generally 1.1 to 3.0 fold in one direction. Further, as described above, it is believed that the film defined in claim 47 possesses various unique and improved properties that are not appreciated or disclosed by Kaneko. As such, Applicant submits that claim 47 also patentably defines over Kaneko.

In the Office Action, claims 1-4, 7-13 and 41 were also rejected under 35 U.S.C. § 102(e) in view of U.S. Patent No. 6,245,401 to Ying. Ying is directed to segmented conformable breathable films. Although Ying does disclose the use of polyurethanes, Ying does not disclose a polyurethane elastomer film containing a filler. For example, in column 10, starting at line 55, the polyurethane films are described as being elastic and breathable but non-porous. As such, it is believed that Ying does not anticipate any of the currently pending claims.

Various claims were also rejected under 35 U.S.C. § 103 in view of Ying. Applicant submits, however, that Ying is not available as prior art to the present application under 35 U.S.C. § 103. For instance, under the provisions of recently amended 35 U.S.C. § 103(c), a patent that qualified as prior art only under § 102(e) is no longer available as prior art under § 103 if the patent and the claimed invention were, at the time the invention was made, subject to an obligation of assignment to the same person or entity. Here, both Ying and the present application are assigned to the same entity. Accordingly, Applicant submits that Ying is not available as prior art to the present application under 35 U.S.C. § 103.

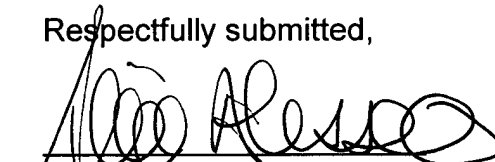
In the Office Action, U.S. Patent No. 6,207,237 to Haffner was also cited in combination with Ying or Kaneko in rejecting various claims. Similar to Ying, however,

Haffner is also not available as prior art under 35 U.S.C. § 103. Haffner is also assigned to the assignee of record.

In summary, it is believed that the present application is in complete condition for allowance and favorable action, therefore, is respectfully requested. Should any issues remain after consideration of this amendment, however, then Examiner Vo is invited and encouraged to telephone the undersigned at her convenience.

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Date

Respectfully submitted,


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